



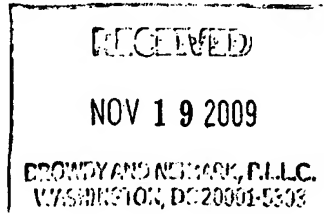
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CLIENT REF. 732744501

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,421	05/17/2006	Jan Clair Nielsen	NIELSEN6A	5536

1444 7590 11/17/2009  
BROWDY AND NEIMARK, P.L.L.C.  
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WASHINGTON, DC 20001-5303



EXAMINER
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GANGLE, BRIAN J

ART UNIT	PAPER NUMBER
1645	

MAIL DATE	DELIVERY MODE
11/17/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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In re Application of :  
Nielsen et al. :  
Serial No.: 10/562,421 :Decision on Petition  
Filed: 17 May 2006 :  
Attorney Docket No.: NIELSEN6A :

This letter is in response to the petition filed under 37 C.F.R. § 1.144 filed on 15 October 2009 requesting reconsideration of the lack of unity requirement.

**BACKGROUND**

This application was filed as a national stage application under 35 USC 371 and as such, is eligible for unity of invention practice.

On 23 June 2008, the examiner divided the claims into 5 Groups as follows:

- Group I, drawn to microbial organisms capable of fermenting malic acid to lactic acid;
- Group II, drawn to methods of degrading malic acid over citric acid and of inducing malolactic fermentation during wine production
- Group III, drawn to method of producing a microbial organisms;
- Group IV, drawn to a activation solution;
- Group V, drawn to process of inducing fermentation with an activation solution

As evidence of lack of special technical feature which makes a contribution over the prior art, the examiner referred to Viljakainen.

\* On 23 September 2008, applicants elected, with traverse, Group I.

On 7 January 2009, the examiner mailed to applicants a non-final Office action. The examiner addressed the traversal and made the restriction requirement final.

Claims 16, 18-20, 22-26, 29, 31, 32, 34, 35, 37, 42, 50-52, 55, 58, 59, 63-66, 68-76, 79-82, 84-88, 90-95 and 98-100 were withdrawn as being directed to non-elected invention.

Claims 1, 2, 4, 6-9, 11, 13-15, 43, 45, 48 and 49 were examined on the merits and rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement.

Claim 15 was rejected under 35 USC 112, first paragraph over the biological deposit of the microorganisms DSM 15569, DSM 15570 and DSM 15571.

Claims 4 and 6-7 were rejected under 35 USC 112, second paragraph for indefiniteness.

On 4 May 2009, applicants filed a response to the Office action.

On 13 August 2009, the examiner mailed to applicants a final Office action. The examiner re-addressed the traversal and made the restriction requirement final.

Claims 16, 18-20, 22-26, 29, 31, 32, 34, 35, 37, 42, 50-52, 55, 58, 59, 63-66, 68-76, 79-82, 84-88, 90-95 and 98-100 were withdrawn as being directed to non-elected invention.

Claims 1, 2, 4, 6-9, 11, 43, 45, 48-49 and new claims 101-103 were rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement.

Amended Claim 8 was rejected under 35 USC 112, first paragraph for new matter

Claim 15 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

On 15 October 2009, applicant submitted the petition currently under review.

On 5 November 2009, applicants filed an amendment after final.

## **DISCUSSION**

The petition and file history have been carefully considered.

MPEP 1893.03(c) states in part:

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which

each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. Note also the examples contained in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO's web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm)).

Either an anticipation rejection (which speaks to novelty) or a non-obvious rejection (which speaks to inventive step) would have been sufficient to show that elected product did not make a contribution over the prior art, such that unity of invention was lacking. See ISPE Guidelines Paragraph 10.02 explains that

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," is considered with respect to novelty and inventive step.

That is not the case here. In both the non-final and final Office actions, the product claims are NOT rejected under either 35 USC 102 or 103.

#### I. Concerning Lack of Unity Amongst Groups I, II and III:

International Search and Preliminary Examination Guidelines provide Example 1 directed to Claims in Different Categories:

##### 10.21 Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X. However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.

Because there is no prior art cited on the elected product (Group I), the corresponding method of making the elected product (Group III) and the method of using the elected product (Group II) have unity of invention with the elected product.

#### II. Concerning the lack of unity between product (Group I) and activation solution (Group IV) inventions:

The ISPE Guidelines provides to examples 13 and 15 which are similar to the inventions of Group I and IV.

##### 10.33 Example 13

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is the filament A.

#### 10.35 Example 15

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

Group I is directed to a microbial organism, while Group IV is directed to an activation solution which requires the microbial organism of claim 1. Because the product of claim 1 makes a contribution over the prior art, the activation solution which requires this product would have unity of invention with Groups I-III.

III. Concerning the lack of unity between activation solution (Group IV) and the method of using the activation solution (Group V):

Group IV is directed to an activation solution, while Group V is directed to a method of using the activation solution which ultimately requires the microbial organism of claim 1. Because the product of claim 1 makes a contribution over the prior art, the method of using the activation solution would have unity of invention with Groups I-IV.

#### **DECISION**

The petition is **GRANTED** for the reasons set forth above.

The lack of unity determination between Groups I-V is withdrawn.

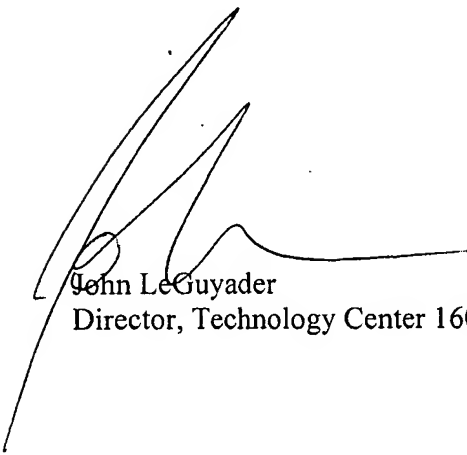
The Office action of 19 December 2009 is withdrawn as incomplete, because there is no rejection under 35 USC 102 or 103 over the elected product and claims which require the elected invention have not been examined.

The amendment filed on 5 November 2009 will be entered.

**The application will be forwarded to the examiner for consideration of the papers filed on 5 November 2009 and for preparation of a supplemental non-final Office action consistent with this decision, in which all pending claims will be examined on the merits.**

Should there be any questions about this decision, please contact Quality Assurance Specialist Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above,

or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number,  
571-273-8300.



John LeGuyader  
Director, Technology Center 1600